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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/796,522

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Joseph F. Poduslo

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EXAMINER

CHERNYSHEV, OLGA N

ART UNIT

PAPER NUMBER

1649

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/13/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/796,522	Applicant(s) PODUSLO ET AL.	
	Examiner Olga N. Chernyshev	Art Unit 1649	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31,33-48 and 51-72 is/are pending in the application.
- 4a) Of the above claim(s) 47 and 51-66 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31,33-46,48 and 67-72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 15, 2006 has been entered.

Response to Amendment

2. Claims 31, 43, 45 and 48 have been amended, claims 32 and 49-50 have been cancelled and claims 69-72 have been added as requested in the amendment filed on December 15, 2006. Following the amendment, claims 31, 33-48 and 51-72 are pending in the instant application.

Claims 47 and 51-66 are withdrawn (claims 51, 54, 57, 59 have been amended) from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant timely traversed the restriction (election) requirement in the reply filed on February 27, 2006.

Claims 31, 33-46, 48 and 67-72 are under examination in the instant office action.

3. The Text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Any objection or rejection of record, which is not expressly repeated in this action has been overcome by Applicant's response and withdrawn.

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5. Applicant's arguments filed on December 15, 2006 have been fully considered. New grounds of rejections are set forth below.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 69-72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 69-70 are vague and ambiguous for recitation of "an human amyloid beta ($A\beta$) polypeptide", emphasis added. The structure of $A\beta$ polypeptide is very well known in the art; therefore, it is unclear what additional significance is intended by adding limitation "human" to the claimed subject matter. Moreover, because the instant specification does not identify that property or combination of properties which is unique to and, therefore, definitive of a "human $A\beta$ ", an artisan cannot determine if a compound which meets all of the other limitations of a claim would then be included or excluded from the claimed subject matter by the presence of this limitation.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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10. Claims 31, 33-46, 48 and 69 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a therapeutic or diagnostic compositions comprising A β polypeptide linked to a non-A β polypeptide for treatment of a human patient diagnosed with Alzheimer's disease, does not reasonably provide enablement for the claimed compositions to treat any CNS disorder. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims.

The instant claims are drawn to a composition for treatment of CNS disorders, wherein the composition comprises A β peptide linked to different non-A β peptides. However, the instant specification fails to provide enough guidance for one skilled in the art on how use of the claimed composition for the treatment of all CNS pathologies, as currently claimed, thereby requiring undue experimentation to discover how to use Applicant's invention.

With respect to claim breadth, the standard under 35 U.S.C. §112, first paragraph, entails the determination of what the claims recite and what the claims mean as a whole. In addition, when analyzing the enablement scope of the claims, the teachings of the specification are to be taken into account because the claims are to be given their broadest reasonable interpretation that is consistent with the specification (see MPEP 2111 [R-1], which states that claims must be given their broadest reasonable interpretation

"During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the

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claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550- 51 (CCPA 1969)".

As such, the broadest reasonable interpretation of the claimed composition is one of being enabled for use in treatment of any CNS disorder. One skilled in the art readily appreciates that "CNS disorders" encompass an exceptionally broad range of different pathological conditions of extremely diverse etiology. The instant specification teaches how to use the claimed composition with respect to clearing amyloid accumulation during Alzheimer's disease, however, it fails to provide any further guidance as how to extrapolate the limited information presented therein to the full scope of the invention, as currently claimed.

A patent is granted for a completed invention, not the general suggestion of an idea and how that idea might be developed into the claimed invention. In the decision of *Genentec, Inc. v. Novo Nordisk*, 42 USPQ 2d 100,(CAFC 1997), the court held that:

"[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable" and that "[t]ossing out the mere germ of an idea does not constitute enabling disclosure". The court further stated that "when there is no disclosure of any specific starting material or of any of the conditions under which a process is to be carried out, undue experimentation is required; there is a failure to meet the enablement requirements that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art", "[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement".

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The instant specification is not enabling because one can not follow the guidance presented therein and practice the full scope of the claimed invention without first making a substantial inventive contribution.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 31, 42-45 and 72 are rejected under 35 U.S.C. 102(b) as being anticipated by Schenk, 1999, WO99/27944.

Claims 31, 42-45 and 72 encompass a therapeutic composition comprising A β peptide linked to a non-A β polypeptide suitable for treatment of CNS disorder. Document of Schenk teaches therapeutic compositions comprising A β peptides and their analogs and derivatives for treatment of Alzheimer's disease, CNS disorder. Specifically, at pp. 15-16, Schenk discloses analogs of A β , which have modifications, such as substitutions and additions (“[A β] analog together with other amino acids”, pp. 15-16) and fusion peptides including antibodies (p. 16), thus fully anticipating the claimed invention.

Claims 67-68 are rejected under 35 U.S.C. 102(b) as being anticipated by Solomon et al., (PNAS USA, 1996, Vol. 94, pp. 4109-4112).

Claims 67-68 are broadly drawn to a composition comprising a A β peptide linked to an antibody. Applicant is advised that the claims, as written, encompass any complex that occurs

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between an A β and an antibody specific for A β , for example. As such, Solomon et al. article discloses an immunogenic covalent complex between different forms of A β and anti- A β antibodies, see Materials and Methods at p. 452 specifically. Thus, article of Solomon et al. fully anticipates the instant claims 67-68.

Conclusion

13. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olga N. Chernyshev whose telephone number is (571) 272-0870. The examiner can normally be reached on 8:00 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet L. Andres can be reached on (571) 272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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A handwritten signature in black ink, appearing to read 'Olga N. Chernyshev', is positioned above the printed name.

Olga N. Chernyshev, Ph.D.

Primary Examiner

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January 16, 2007